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NOV 27 2006

REPLY TO YAKIMA**FACSIMILE TRANSMISSION COVER SHEET**Date: **November 27, 2006**Our File No.: **HR1.P04**Number of Pages: **33** (not including this page)

To: **Susan McCormick-Ewoldt, Art Unit 1661**

Company Name: **U.S. Patent and Trademark Office**

Facsimile No.: **(571) 273-8300**

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From: **Michelle Bos**

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**RECEIVED
CENTRAL FAX CENTER****NOV 27 2006****PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Peter Collinge
Serial No.: 10/032,692
Title of Invention: APPLE VARIETY NAMED 'CJ07'
Filing Date: December 27, 2001
Examiner: S. McCormick-Ewoldt, Art Unit 1661
Docket N°: HR1.P04

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450


CERTIFICATE OF TRANSMITTAL BY FACSIMILE

Fax No.: (571) 273-8300
Date of Transmission: November 27, 2006

I hereby certify that the following papers and fees:

1. Substitute Appeal Brief

are being transmitted via facsimile on the date indicated above to the Commissioner for Patents, Alexandria, Virginia 22313-1450.


Michelle Bos

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter Collinge
Serial No.: 10/032,692
Title of Invention: APPLE VARIETY NAMED 'CJ07'
Filing Date: December 27, 2001
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 27, 2006
Yakima, Washington 98902

SUBSTITUTE APPEAL BRIEF

Sir:

This Substitute Appeal Brief is submitted in response to the Notification of Non-Compliant Appeal Brief dated October 27, 2006.

The following paragraphs are identified by paragraph numbers, which correspond with the requirements for an Appeal Brief set forth in 37 CFR 41.37.

Serial No. 10/032.692
SUBSTITUTE APPEAL BRIEF - Page 2

1. Real Party in Interest:

The Horticulture and Food Research Institute of New Zealand Ltd., assignee of record of the entire right, title and interest in the patent application, is the real party in interest in this appeal.

2. Related Appeals and Interferences:

Pending U.S. plant patent application nos. 09/449,135, 09/590,861, and 09/905,574 have been appealed to the Board of Patent Appeals and Interferences for consideration of the same issue that is raised in this appeal. Application No. 09/905,574 is owned by the owner of the currently appealed application. Other than these related applications, there are no pending appeals or interferences known to the appellant, the appellant's legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

3. Status of Claims:

This appeal relates to a plant patent application under 35 USC 161 *et seq.*, and as such includes a single formal claim directed to the plant shown and described in the specification. The claim stands rejected under 35 USC 112. Applicant hereby appeals the rejection of the single claim in the application.

4. Status of Amendments:

All amendments submitted by the Applicant have been entered.

5. Summary of Claimed Subject Matter:

The invention is a new and distinct apple tree named 'CJ07.' 'CJ07' originated as a whole tree mutation of its parent 'Sciearly' (USPP 11,092), distinguishable from its parent by early development of bright red fruit color.

6. Grounds of rejection to be reviewed on appeal:

The application stands rejected under 35 USC 112, first and second paragraphs. The issue on appeal is whether the specification meets the written description requirements of 35 USC 112, first and second paragraphs, and 35 USC 162.

7. Argument:

The application has been rejected under 35 USC 112, first and second paragraphs. The Examiner in this application contends that the specification does not meet the requirements set forth in 35 USC 112, first and second paragraphs, because the Applicant has not supplied botanical detail regarding the new plant in sufficient detail to meet the requirements of the statute. Specifically, the Examiner asserts that the description of the variety is incomplete because the Applicant has provided allegedly inadequate descriptions of certain botanical features of the claimed plant. The Applicant contends that the specification is reasonably complete, and that the rejection under 35 USC 112 is improper. Applicant's position is well supported by statutory and judicial law, as set forth in the following paragraphs.

History of the Written Description Requirement for Plant Patents (35 USC 112, 162)

Congress passed the Plant Patent Act (now 35 USC 161 et seq.) in 1930 to give to plant breeders the same rights afforded to those in industry who invent and improve technology. At the time the Act was passed, Congress recognized that plant patent applications could not contain an enabling description of the plant to be patented, so the Act was written to include a special exception with respect to the written description requirements of 35 USC 112, first and second paragraphs. In what is now 35 USC 162, Congress modified the application of 35 USC 112 to plant patents:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. . . .

At no time since the inception of the Plant Patent Act of 1930 has an Applicant for a plant patent been required to provide an enabling description of the variety for which plant patent protection is being sought. The applicable standard for the written description of the new plant

variety claimed in the present application is the "complete as reasonably possible" standard set forth in 35 USC 162. The standard is further borne out in 37 CFR 1.163(a):

The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents...

In the present application, the Applicant has provided a skillfully written botanical description of the new plant to be patented, including a description of the characteristics that distinguish the new plant. At no point in the prosecution has the Examiner indicated that the specification fails to distinguish the new plant over its parent or other known varieties, nor has the application been rejected under 35 USC 102.

Scope of the Plant Patent Claim

The scope of the claim in a plant patent application is established by statute. 35 USC 163 reads:

In the case of a plant patent, the grant shall include the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

Unlike utility patent claims, the scope of the claim in a plant patent is unaffected by the scope of the written description or the language of the claim itself. The botanical description and illustrations included in a plant patent application assist in identifying the plant claimed, but have no impact on the scope of the claim. The scope of the claim in a plant patent includes the specific plant described and pictured in the specification, as well as any plants asexually reproduced from that plant. No other plant can fall within the scope of the plant patent claim, regardless of apparent similarity or

even identity with the claimed plant. (*See Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, discussed below). In recognition of the immutability of the scope of a plant patent claim, 35 USC 162 provides that “The claim in the specification shall be in formal terms to the plant shown and described.”

Applicant Has Met the Requirement that the Description be Reasonably Complete

35 USC 162 acknowledges that an enabling written description cannot be provided for a plant, and allows instead a reasonably complete description. Applicant asserts that for the purposes of a plant patent specification, a reasonably complete description identifies the novel, distinguishing, and non-variable characteristics of a new plant variety, and additionally points out commercially relevant features of the variety. A reasonably complete description does not include each and every quantifiable feature of the plant. While a highly detailed description may have merit for some purposes (such as breeding program records, botanical publications, researcher’s notes, etc.), it is neither required by law nor appropriate in a plant patent application.

A highly detailed and exacting patent specification may be appealing to a botanist, a patent Examiner, or a patent Applicant, but it is not more useful in defining the scope of the enforceable rights of the patent owner than a reasonably complete specification that points out the distinguishing characteristics of the variety.

A quantitative recitation of variable characteristics fails as a “reasonably complete” description as required by the statute. Without taking into consideration the unique attributes of plants as patentable subject matter, one might conclude that if some description is good, i.e., reasonably complete, then more description must be better. In a utility patent application, this may be true. In a plant patent, however, no such description is required, or useful. The botanical description in a plant

patent application is intended to aid in identifying the claimed plant, not to enable the reader to make the invention. A botanical description which exceeds the "reasonably complete" standard by providing a description of variable characteristics does not aid in identifying the plant, but in fact introduces vague and ambiguous information. Rather than serving to improve the quality of the disclosure in a plant patent application, the addition of unnecessary, vague or ambiguous information diminishes its value as an aid in identifying the claimed plant. A reasonably complete description of a plant is limited to characteristics which are not subject to a great deal of variability, and which are used by those skilled in the art to identify plants of the variety claimed.

Many of the characteristics for which the Examiner has requested additional descriptive information are subject to substantial variability. Some of the variables which can affect the observable characteristics of fruit trees include: soil type; fertilizers and agricultural chemicals; weather; climate; watering; plant stress; cultural practices; and disease. For example, the Examiner has objected to Applicant's description of the claimed apple tree as being of medium size and vigor, asserting that more specific information is required, i.e., "height and spread for the observed tree" and "amount of growth over a specified period of time." Final Office Action, page 3, paragraph A. A quantified measurement of the tree is meaningless in light of the above named factors, and others. Commercial fruit trees are planted on rootstocks, which greatly affect tree size and vigor. Furthermore, commercial fruit trees are pruned on an annual basis, making measurements of "tree size" meaningless. Because these trees are tested and grown under commercial orchard conditions, any measurement of an unpruned tree growing on its own root system has no comparative value. The general description provided is sufficient.

The Examiner has also requested highly detailed information regarding the buds, flowers and reproductive organs of the claimed plant. Final Office Action, page 4, paragraphs F-K. Applicant

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believes that this information is not reasonably necessary to describe the claimed plant. 'CJ07' is a commercial fruit tree, bred, observed, selected, and grown for its desirable fruit. Only general information regarding the bloom of the 'CJ07' tree has been provided, because little or no attention is paid by those skilled in the art of commercial horticulture to the appearance of the flowers. Certainly more information would be appropriate if this was an ornamental variety, but it is not.

The arguments above also apply to paragraphs B, C, D, E, L, M, O, P and R of the Final Office Action.

The Examiner has required that the Applicant provide additional information regarding the fruit flesh. Final Office Action, page 4, paragraph N. ("Applicant failed to describe the texture of the flesh of the observed fruit. Applicant should utilize a more appropriate term such as -fine-grained-, -smooth- or -crisp- as 'Medium' in [sic] insufficient in this regard. Correction is needed.") Applicant believes that the description provided in the specification as filed is more than adequate. Specification, p. 5 ("Flesh: Medium firm, juicy and crisp; tinged light yellow RHSCC 10D). No additional information should be required regarding fruit size.

The Examiner has asserted that Applicant must provide additional information regarding the known shipping and storage characteristics of the fruit of the claimed variety in order to complete the description. Final Office Action, page 4, paragraph O. Applicant declined to provide additional information on this point, because all known information was provided in the application as filed. No additional descriptive information should be required regarding the fruit of the claimed plant.

The Examiner asserts that the request for additional botanical description is not unreasonable because the information requested can be obtained with a color chart and a measuring device. Applicant contends that the botanical information requested by the Examiner is neither necessary nor

appropriate in this application, for the reasons set forth above, regardless of the ease with which the information might be gathered.

A Highly Detailed Botanical Description Does Not Aid the PTO in Examining Plant Patent Applications

The Examiner has argued that a highly detailed botanical description is necessary for the Examiner to make a comparison of the new variety to other known varieties, and to future varieties for which applications may be filed. Even if Applicant were to present an exhaustive botanical description of variable characteristics, pointing out the conditions under which the new plant was grown, the chances that those conditions would be identical to the conditions under which a future new variety would be grown are slim at best. The PTO still could not make a meaningful comparison of variable characteristics. As the Examiner has pointed out, only a side by side growing trial will serve to distinguish closely related varieties.

The Examiner expresses concern that a "vague and incomplete" written description may make it difficult for an examiner to compare the claimed plant to a plants claimed in future applications, and may result in rejections under 35 USC 102 of later filed applications. This concern is misplaced. An anticipation rejection under Section 102 must be based on a single reference that discloses each and every element of the claimed invention. Donald S. Chisum, Patents, §3.02. ("To anticipate a claim for a patent, a single prior source must contain all its essential elements.") Chisum goes on to state:

Similarity or identity such as will negate novelty and constitute anticipation is determined by reference to the language of the claim of the patent or application. In this respect, the inquiry as to anticipation is symmetrical with the inquiry as to infringement of a patent. The classic test of anticipation provides: "That which will infringe, if later, will anticipate, if earlier." Thus, a claim fails to meet the novelty

requirement if it covers or reads on a product or process found in a single source in the prior art.

Donald S. Chisum, Patents, §3.02[1], footnotes omitted.

The statutorily prescribed scope of a plant patent claim is the specific plant claimed and its asexually propagated progeny. Thus, only the claimed plant itself can anticipate. Any other plant or description thereof cannot, as a matter of law, anticipate a plant invention. A plant patent application having a description identical to a previously issued plant patent is not properly rejected under Section 102, unless it can be shown that the claimed plant is the asexually propagated progeny of the patented plant (or vice versa).

Application of *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560 (Fed. Cir. 1995) to Written Description Requirement in Plant Patent Applications

In the case of *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, the Federal Circuit considered the question of whether a plant patent could be enforced against an infringer absent a showing that the infringer had access to the patented variety. Imazio had accused Dania of infringing its patent for a unique heather plant, claiming that the plants being grown and sold by Dania were substantially identical to the plant described in Imazio's plant patent. The Federal Circuit ruled that, absent some showing that Dania had access to Imazio's patented plant material, no infringement could be found. *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, citing *Yoder Bros., Inc. v. California-Florida Plant Corp.*, 537 F.2d 1347, 1390. ("The patentee must prove that the alleged infringing plant is an asexual reproduction, that is, that it is the progeny of the patented plant.")

The decision in the *Imazio* case reaffirms and clarifies the intentions of Congress with respect to the written description requirement for plant patents. There is no requirement, or even possibility, of providing an enabling written description in a plant patent application. Even the most exacting

description of a first plant variety does not anticipate a second plant of identical description, absent a showing that the second plant is the asexually propagated progeny of the first.

Application of *In Re Greer*, 484 F.2d 488 (CCPA 1973) to Written Description Requirement in Plant Patent Applications

The U.S. Court of Customs and Patent Appeals considered the issue of descriptiveness in a plant patent application in the case of *In Re Greer*, 484 F.2d 488 (CCPA 1973). In his plant patent application, Applicant Greer had failed to provide information sufficient to fully distinguish his new variety of Bermuda grass over known varieties. The USDA assisted in the examination of the application, and determined that the description of the claimed grass was not adequate to determine if it differed from other named Bermuda grasses. In upholding the PTO's rejection of the application, the CCPA explained the Applicant's duty to "provide information of such a character that a meaningful comparison can be made."

Cecil Greer's patent application was rejected on appeal because he failed to distinguish his new variety from the parent and other known varieties. This is not the case in the present application. Applicant has clearly and at some length described the distinguishing features of the variety. The Examiner has not cited other varieties as anticipating the new variety, or even suggested that the new variety is indistinguishable from its parent or from any other known peach tree.

Requirement that Applicant Conform Written Description to Terms Selected By Examiner is Unreasonable

The present application has been rejected because the Applicant has declined to provide the specific botanical information requested by the Examiner. The application contains a substantial and reasonable botanical description of the claimed plant. The Examiner's request for additional

information is unsupported by specific reasons as to why such detail is necessary to a reasonably complete description, other than that the descriptive categories in question have appeared in other patents. The Examiner has apparently relied upon previously issued patents to suggest the need for specific additional descriptive information. However, the Examiner did not acknowledge or respond to Applicant's argument that elements of the botanical description as filed in this application are in relative terms very similar to those used in the patent application for the parent variety, 'Sciearly.'

Applicant has reviewed a large number of issued plant patents, and notes that there is substantial variability in the amount and precision of botanical descriptions provided. See, for example, U.S. Plant Patent Nos. 10,114, 10,458, 13,753 and 11,092. Each of these issued 'Gala'-type apple tree patents presumptively contains a "reasonably complete" botanical description, although each is unique and may provide more or less detail on a given characteristic as compared to another patent. Note, for example, the variation in the botanical descriptions included in the above named patents, as compared with the botanical description provided for 'CJ07' as shown in Table 1 (next page):

Table 1: Comparison of Botanical Detail Provided in Various Issued Plant Patents and 'CJ07' Application

	PP 10,114	PP 10,458	PP 13,753	PP 11,092	CJ07
Tree size	Medium	Medium-small	Medium size typical of other Gala trees, semi-dwarf due to dwarfing rootstock. Height 8 - 10 ft. Width 7 - 9 ft.	Medium	Medium
Petiole size	Medium, 1 to 1.25 inches	28 mm long, thick	22 to 37 mm; average 26 mm (1.5 mm average diameter.)	Length 2.8 cm	Length 30 - 45 mm
Flower	Similar to Tenroy cv.; medium timing; medium size; white petals with pink each side; sterile; many flower clusters similar to Gala	Size: medium, larger than Gala. Color: White when open, pink before opening. Flowering period: April 22-April 29. Pollinators: Any diploid in same season	Large, 52-60 mm; pink in bud stage, white in full flower; bud color 2.5t 7/6; 5 petals, rounded apex, acuminate base, smooth margin and texture, margins touching to overlapping	Medium time of beginning of flowering, blossom about Oct. 5; full bloom October 10; medium size; flat shape; margin of petals overlapping; color of bud just before flower opens, pink, 63C	Medium blooming period, starting about 5 October for 2 weeks; medium size; margin not touching; bud colour pink RHSCC 55b fading to white as flower opens; 5 small sepals, pointed green with red tips
Reproductive organs	--	--	Stamen single row, anthers bright yellow 2.5Y 3.5/12; pistil - stigma medium length, branched at top into 5 elements; styles medium	--	Pubescent ovary
Storage & shipping	--	Keeping quality good, 3 months in common refrigerator	--	Keeping quality very good. No significant disorders after 100 days storage	Keeping quality excellent
Disease resistance & susceptibility	--	"None noted"	--	Medium susceptibility to major pests and diseases of apple	--

In the absence of an approved plant description template¹, an Applicant for a plant patent must have a reasonable amount of freedom in describing the claimed plant. As shown in Table 1, that freedom has typically been afforded Applicants in the past. Otherwise, the result is uncertainty on the part of the applicant in determining what information to observe, record, and include in a patent specification. If the Applicant does not include certain information that the Examiner later determines, based on some unknown criteria, is necessary for a reasonably complete description of the plant, the Applicant is sent back to the field to gather the information, or, as in this case, is faced with the rejection of its application. 'CJ07' has been described in terms very similar to those used in the patent for its parent 'Sciearly,' but for reasons that the Examiner has not explained, what was sufficient for 'Sciearly' is not sufficient for 'CJ07.'

Due to the nature of living organisms, certain botanical features are available for observation only during limited periods during the growing cycle of a plant. In the case of permanent crop plants such as trees, shrubs and vines, some information is available only for a brief period during the year. If the timing of the Examiner's request does not coincide with the availability of data, the applicant must suspend or continue its application in order to avoid abandonment, while it waits to obtain the necessary information when it becomes available. This uncertainty places a burden on the applicant which, in light of the above arguments regarding the scope of the plant patent claim and absence of a requirement for an enabling written description, is unreasonable.

In the present plant patent application, Applicant filed a skillfully prepared botanical description of its new apple tree. For all of the reasons expressed above, Applicant believes that no

¹ The International Union for the Protection of New Varieties of Plants (UPOV) has developed Testing Guidelines to be used to describe new plant varieties in which rights are claimed. Although the United States is a member of UPOV, the USPTO does not recognize the UPOV Testing Guidelines.

further botanical description is required, and that the Examiner's rejection under 35 U.S.C. §§112 and 162 is in error.

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8. Claims Appendix:

The single claim on appeal is as follows:

We claim a new and distinct apple tree, substantially as shown and described herein.

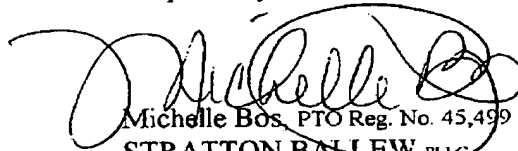
9. Evidence Appendix:

None

Conclusion

For the reasons stated above, Applicant believes that the plant patent application for "Apple Variety Named 'CJ07'" meets the requirements of 35 USC 112, first and second paragraphs, and 35 USC 162. Accordingly, Applicant respectfully requests that the Board of Patent Appeals and Interferences overturn the Examiner's rejection in this case, and remand the application to the Examiner for allowance and issuance. Any questions or comments relating to this application may be directed to the Applicant's representative who signs below.

Respectfully Submitted,



Michelle Bos, PTO Reg. No. 45,499

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

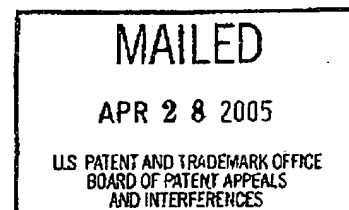
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte EVERETTE W. BRANDT

Appeal No. 2004-1830
Application No. 09/590,861

HEARD: March 8, 2005



Before WILLIAM F. SMITH, SCHEINER, and ADAMS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Having heard oral argument on March 8, 2005, and taking the appeal under advisement, we have determined that this case is not in condition for a decision on appeal. Accordingly, we remand the case to the examiner to consider the issues raised below and take appropriate action.

Background

This plant patent application describes a nectarine tree denominated "DN-02." According to appellant, DN-02 is "distinguishable from other nectarine varieties by the unique flattened shape of its fruit." Specification, page 1.

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Application No. 09/590,861

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Figures 1-5 of the application are stated to respectively show a representative fruit, the flesh of a representative fruit, the stone of a representative fruit, a representative branch and a representative limb of DN-02. Id. DN-02 is stated to be a "limb sport mutation from a peento-type peach . . . tree of unknown origin, and was found in a cultivated orchard near Parker, Washington." Id.

Appellant provides a botanical description of DN-02 on pages 2-5 of the specification which is stated to be based on observations made in Parker, Washington, U.S.A. Id., page 2. Appellant indicates that, since the botanical description resulted from the ecological conditions that existed in the area of Parker, Washington, U.S.A., where DN-02 was grown and tested, it is to be expected that variations of the described characteristics may occur if DN-02 is grown in areas under different climatic conditions, soil types and/or varying cultural practices. Id., pages 5-6.

The present claim stands rejected under 35 U.S.C. § 112, first and second paragraphs. Examiner's Answer, page 4. The examiner lists specific concerns in regard to how the specification describes DN-02 as items A - U on pages 4-7 of the Examiner's Answer.

In response, appellants do not directly respond to any of the specific points A - U set forth in the Examiner's Answer. Rather, the position taken by appellant in the Appeal Brief¹ is that the specification is reasonably complete and meets the requirements of the statute. See, e.g., Appeal Brief, page 3.

¹ Reference to the "Appeal Brief" in this opinion is to the "Supplemental Appeal Brief," Paper No. 21.

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Finally, we note the claim in this plant patent application is not rejected on prior art grounds.

Remand

The Manual of Patent Examining Procedure (MPEP) § 1208, (Rev. 2, May 2004), provides:

If an examiner's answer is believed to contain a new interpretation or application of the existing patent law, the examiner's answer, application file, and an explanatory memorandum should be forwarded to the TC Director for consideration. See MPEP § 1003. If approved by the TC Director, the examiner's answer should be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for final approval.

In our view, the issues raised in the present rejection are based upon a new interpretation or application of the existing patent law and the rejection should be reviewed according to the procedure set forth in this section of the MPEP.

35 U.S.C. § 162 (Rev. 2, May 2004) states in relevant part:

No plant patent shall be declared invalid for non-compliance with section 112 of this title if the description is as complete as is reasonably possible.

37 CFR § 1.163(a) (July 2004) sets forth how a plant should be described in the specification of a plant patent application as follows:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

Section 162 of the Code only requires that the plant be described in the specification "as complete as is reasonably possible" in order to comply with § 112.

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Rule 163 appears to be more restrictive than the statute in that the rule requires the specification contain "as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents" The tenor of Rule 163(a) is that the description of the plant in the specification must be sufficient so that the claimed plant can be distinguished from other known varieties and the claimed plants antecedents.

Here, the description of DN-02 in the specification appears to have been sufficient for the examiner to compare DN-02 to prior art nectarine trees and determine the DN-02 is free of the prior art since the examiner has not specifically tied any of points A-U to an inability to compare DN-02 to the prior art and has not applied a prior art rejection. Rather, the examiner's concern appears to be directed to future events such as examination of plant patent applications directed to other nectarine trees and being able to distinguish those future trees from DN-02. For example, the examiner states "[a]s the list of issued plant patent grows, complete and concise descriptions are needed to aid in examining future plant patent applications." Examiner's Answer, page 9.

This aspect of the examiner's position appears to be a new interpretation of the patent laws in that the examiner has not cited any authority in support of the proposition that the description of a plant in a plant patent application must be sufficiently complete and concise so that the description is an aid in examining future plant patent applications as opposed to describing the new plant in such a manner that the patentability of the plant under review can be determined.

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Another aspect of the examiner's position that should be reviewed upon return of the application is the potential that this new standard of description for a plant patent may become arbitrary. While in no way suggesting the examiner in this application was arbitrary, we note the final rejection of this application (Paper No. 15) lists points A - K as reasons in support of the rejection. Final Rejection, pages 2-3. Upon filing a first Appeal Brief (Paper No. 17, January 13, 2003), the examiner reopened prosecution and expanded the reasons why the specification of this plant patent application was purportedly deficient. As seen from the Examiner's Answer, the examiner now relies upon points A - U. It may be that focusing on the description of a plant in a plant patent application for the purpose of completeness to compare the claimed plant to possible future plants can become a never ending process with an applicant meeting an examiner's request for more descriptors only to be met with a new list of concerns.

The examiner has made of record four plant patents directed to nectarine trees.² A review of these four plant patents reveals that the individual nectarine trees are described in a variety of ways and there is no one set way in which a nectarine tree must be described in order for an examiner to determine whether it distinguishes from prior art trees and the claimed trees antecedents. At oral argument, counsel indicated there is an international standard for describing plants. However, the briefing in this case makes no reference to such a standard so we are not in a position to review or comment upon such a standard.

²

Marshall	8,570	Feb. 1, 1994
Escande	9,107	Apr. 18, 1995
Bradford et al. (Bradford '695)	11,695	Dec. 12, 2000
Bradford et al. (Bradford '711)	11,711	Dec. 19, 2000

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A review of the case law is not helpful in this situation. The one case we are aware of directed to sufficiency of disclosure of plant patent applications, In re Greer, 484 F.2d 488, 179 USPQ 301 (CCPA 1973), was focused on whether the specification of that plant patent application provided a sufficient description of the claimed Bermuda grass plant such that a meaningful comparison with prior art plants could be made. In that case, the PTO submitted the application to the Department of Agriculture for evaluation of the assertions made that the claimed Bermuda grass was a distinct and new variety of plant. As reported in Greer, the Department of Agriculture's report stated that "[t]he description of the claimed grass is not adequate to determine if it differs from other named bermudagrasses." Id. at 490, 179 USPQ at 303. The court stated in considering the disclosure requirements of 35 U.S.C. § 162:

Nevertheless, we do not agree that it was contemplated by Congress that its incorporation into R.S. 4888 of the matter which is the statutory predecessor to § 162 would operate to allow an applicant to allege characteristics which might be capable of distinguishing one variety of plant from another without sufficient disclosure to establish that these characteristics are indeed present in the claimed plant and absent in the varieties to which it is most closely related. In fact, the portion of the legislative history relied upon by the board makes it clear that the applicant bears the burden of clearly and precisely describing those characteristics which define the new variety.

Id. at 491, 179 USPQ at 303. The court then concluded that "it is incumbent upon the applicant to provide information of such a character that a meaningful comparison can be made." Id. The comparison referenced was with prior art plants, not plants that may be claimed in future plant patent applications.

Another point that should be considered upon return of this application is whether the examiner's concerns in regard to the description of DN-02 in the

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specification are better addressed by way of an objection to the specification which would be reviewable by petition under 37 CFR § 1.181 instead of a rejection of the claim and an appeal as has occurred. Since the description of DN-02 supplied by appellant to date is adequate for the examiner to examine the merits of the claimed nectarine tree and determine that it is free of the prior art, we do not have the situation that occurred in In re Greer. Rather, the examiner's concerns regarding future events and whether the description of DN-02 is adequate to distinguish DN-02 from future nectarine trees appear to be more of a policy question rather than a merits question that would be more readily addressed by way of an objection to the specification which a dissatisfied applicant may have reviewed by way of petition. See In re Hengehold, 440 F.2d 1395, 1404, 169 USPQ 473, 479 (CCPA 1971) (Not every adverse decision by an examiner is "perforce reviewable by the [Board]....There are a host of various kind of decisions an examiner makes in the examination proceeding—mostly matters of a discretionary, procedural or nonsubstantive nature—which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejection of claims, but traditionally have been settled by petition to the [Director].").

Finally, another reason why the examiner's position should be reviewed in accordance with the procedure set forth above in MPEP 1208 is appellant's statement at page 2 of the Appeal Brief that "the issue in this case...is relevant to many pending plant patent applications that have been rejected on the same grounds as the present

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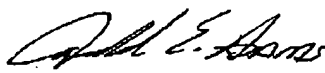
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case." Such wide ranging issues of first impression should be reviewed as indicated in
MPEP 1208.

REMANDED


William F. Smith
Administrative Patent Judge


Toni R. Scheiner
Administrative Patent Judge


Donald E. Adams
Administrative Patent Judge

BOARD OF PATENT

APPEALS AND

INTERFERENCES

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